

REMARKS

By this amendment, claims 5, 27, 31, 36, 39, and 40 have been amended. Claims 1-4, 6-8, 10-11, 23-26, 28-30, 32-35, and 37-38 have been canceled. New claims 41-44 have been added. Claims 5, 9, 27, 31, 36, 39, and 40-44 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Applicant respectfully submits that the claims are not directed toward an "intended use," but toward an apparatus configured to perform specific actions. A limitation including an element "for" performing a function is a structural limitation. *See In re Shaffer*, 108 USPQ 326, 329 (CCPA 1956) (circuit for attenuating is a structure). Moreover, even "statements of intended use ... may ... limit apparatus claims ... if the applicant clearly and unmistakably relied on those uses ... to distinguish prior art." *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809, 62 U.S.P.Q.2d 1781 (Fed. Cir. 2002).

Thus, the claimed apparatus, as embodied by independent claims 1, 23, and 34, includes an image information device for capturing image information of a semiconductor wafer substrate before droplets of raw sealant is discharged onto the substrate. Furthermore, the image information device is configured to provide the image information to a control unit. The control unit is constructed to calculate a position for discharging droplets of raw sealant resin on a first surface of the substrate based upon the image information. As such, the limitations of claims 1, 23, and 34 define a structure which is different from that disclosed in the cited references. The Examiner continues to deliberately ignore the claim limitations. Examiner's Answer pages 18-19. It should be

noted that M.P.E.P. §2115, relied on by the Examiner, specifically states that it “does not apply to product claims,” as in the presently claimed invention.

In addition, the “means for” limitations of claims 23-33 do not fall under MPEP § 2114, as indicated by the Office Action. Rather, the “means for” limitations are “means plus function” limitations in accordance with MPEP § 2181. According to the MPEP, “where means plus function language is used to define the characteristics of a machine..., such language must be interpreted to read on only the structure ... disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function.” MPEP § 2106(II)(C). Again, these are structure claims and the limitations simply cannot be ignored, as done in the Examiner’s Answer (page 19).

Claims 1-2, 6-8, 10-11, 23-24, 28-30, and 32-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ciardella I (US 5,711,989). This rejection is now moot, as the rejected claims have been canceled.

Claims 1-2, 4, 6-8, 10-11, 23-24, 26, 28-30, 32-36, 38, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bouras (US 5,906,682) with reference to Ciardella II (US 5,505,777) (incorporated by reference into Bouras). This rejection is now moot, as the rejected claims have been canceled.

Claims 4, 26, 34-36, 38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciardella I in view of Bouras. This rejection is respectfully traversed. Claims 4, 26, 34-35, and 38 have been canceled.

Claim 36 recites that “said control unit controls said discharging head and said drive mechanism such that said first surface of the semiconductor wafer substrate is covered by said raw sealant resin except for a tip portion of said protruded-shaped electrode” (emphasis added). Applicant respectfully submits that Ciardella I is not combinable with Bouras et al. to teach or suggest this limitation. Bouras et al. teaches that the “desired quantity of adhesive is sufficient to ensure that each of the solder ball-to-solder pad connections of the flip chip 10 is encapsulated with liquid epoxy.” Col. 6, ln. 32-36. Therefore, Bouras et al. teaches away from leaving the tip portion of the electrode uncovered, as claimed. “[S]tatements of intended use ... may ... limit apparatus claims ... if the applicant clearly and unmistakably relied on those uses ... to distinguish prior art.” *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809, 62 U.S.P.Q.2d 1781 (Fed. Cir. 2002). The Office Action relies on Ciardella I to teach this limitation, however, no cite is given; in fact, Ciardella I is silent with respect to this limitation. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 36 be withdrawn and the claim allowed.

Claims 3, 5, 25, 27, 31, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciardella I, or Bouras et al./Ciardella II, or Ciardella I in view of Bouras, in view of Nakazawa et al. (US 5,935,375). This rejection is respectfully traversed. Claims 3, 25, and 37 have been canceled. Claims 5 and 31 recite limitations similar to claim 36; therefore, Nakazawa et al. does not cure the above-discussed deficiencies of the Ciardella I and Bouras et al. combination. Similarly, Ciardella II is not combinable with Bouras et al., which teaches away from “excluding at least a portion of said electrode” from being covered by resin, as claimed. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 5 and 31 be withdrawn and the claims allowed.

Claims 5, 9, 27, 31, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciardella I, or Bouras et al./Ciardella II, or Ciardella I in view of Bouras, in view of Prentice (US 6,007,631). This rejection is respectfully traversed. As discussed above, Bouras et al. teaches away from excluding at least a portion of said electrode from being covered by resin, as recited in claims 5, 9, 27, 31, and 39. Therefore, Prentice does not cure the deficiencies of the Ciardella I and Bouras et al. combination or the Ciardella I and Bouras et al./Ciardella II combination. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 5, 9, 27, 31, and 39 be withdrawn and the claims allowed.

Claims 5, 9, 27, 31, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciardella I, or Bouras et al./Ciardella II, or Ciardella I in view of Bouras, in view of Cavallaro (US 6,017,392). This rejection is respectfully traversed. As discussed above, Bouras et al. teaches away from excluding at least a portion of said electrode from being covered by resin, as recited in claims 5, 9, 27, 31, and 39. Therefore, Prentice does not cure the deficiencies of the Ciardella I and Bouras et al. combination or the Ciardella I and Bouras et al./Ciardella II combination. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 5, 9, 27, 31, and 39 be withdrawn and the claims allowed.

New claims 41-42 include the above-discussed limitations, and are patentable on their own merits. Specifically, none of the cited references discloses, teaches, or suggests “a sealant resin layer having an uneven surface structure” or that the uneven structure is concave, as claimed.

In view of the above, Applicant believes the pending application is in condition for allowance.

Dated: April 1, 2008

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